

REMARKS

Claims 14, 16 to 18, and 20 to 39 are pending in the present application.

In view of the following remarks, Applicants respectfully submit that all of the presently pending claims are allowable, and reconsideration of the present application is respectfully requested.

Claims 14, 16 to 18, and 20 to 39 were rejected under the second paragraph of 35 U.S.C. § 112 as indefinite.

Specifically, the indefiniteness rejections concern the feature in which “each display adaptation has a substantially different non-zero wireless data transmission requirement”. This feature provides that each of several display adaptations requires a wireless data transmission rate, so that at least a plurality of these data transmission rates are substantially different and greater than zero. For example, the specification (at page 2, lines 21 to 22) describes and discloses that the “speed-adjusted representation of said services on the output medium, as well as speed-dependent selection of the input and/or output medium, *and the adaptation of these media according to speed.*” The service unit may “make a different, (speed-)specific adjustment: For example, it can request up-to-date traffic information for navigation in fast succession when the speed is increased.” (Specification, page 5, lines 2 to 4). Further, “user interfaces . . . are then specifically adjusted for said services depending on the magnitude of the speed. The control of service . . ., with regard to their selection, as well as the control of the data flow, such as the frequency of requests, or other important parameters for the provision and selection of the services, are also carried out as a function of the speed.” (Specification, page 5, lines 6 to 11; page 7, lines 10 to 16; and page 8, lines 5 to 19).

It is believed and respectfully submitted that a person of ordinary skill in the art would have readily understood the feature in which “each display adaptation has a substantially different non-zero wireless data transmission requirement” -- especially in view of the disclosure of the specification.

While the rejections may not be agreed with, to facilitate matters, claims 14, 25, 26 and 38 have been rewritten to better clarify the claimed subject matter.

It is therefore respectfully requested that the indefiniteness rejections be withdrawn.

Claims 14, 16 to 18, 20, 24, 27, 28, 30, 31, 38, and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over of Japanese Patent Application Publication No. 2001-119451 ("Andreas") in view of U.S. Patent Publication No. 2008/0147401 ("Odinak"), in further view of U.S. Patent Publication No. 2004/0121774 ("Rajkotia"), and in further view of U.S. Patent 7,239,632 ("Kalavade").

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, at 1741. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

It is believed and respectfully submitted that the applied references do not disclose the feature in which "at least one service uses at least one output medium, including at least one video output medium that includes at least two display adaptations of one service, while in an active state, wherein each display adaptation has a substantially different non-zero wireless data transmission requirement", as provided for in the context of the presently claimed subject matter.

Figure 6 of Rajkotia is conclusorily asserted as to this feature, but it clearly does not disclose any such feature. This portion of Rajkotia generally refers to selecting base stations based on location and velocity. It says nothing about a display, at least two

adaptations of the display, a transmission rate associated with each display, nor those transmission rates being substantially different (and non-zero). The Rajkotia reference does not disclose this feature, so that claim 14 is allowable.

Still further, the conclusory statements in the Final Office Action do not properly establish even a *prima facie* case of obviousness. As clearly indicated by the Supreme Court in *KSR*, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. See *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, at 1741.

Further, the combinations would not have been obvious. First, it is in no way apparent how "selecting based on speed as taught by Rajkotia" is in any way related to "a video output medium as taught by Odinak." Further, it is even less clear how a video output medium is even capable of being "improve[d by] handoff performance." As to Kalavade and "to increase coverage so service is not interrupted," Kalavade itself is simply unrelated to this alleged "obvious" benefit, generally describing only a selection of network based on transmission rate.

Moreover, the four references are wholly unrelated, so that they do not support a substantive case of obviousness. Further, as the conclusory statements fail to provide an "articulated reasoning with some rational underpinning," a *prima facie* case of obviousness has not been made.

Accordingly, claim 14 is allowable, as are its dependent claims 16 to 18, 20, 24, 27, 28, 30, and 31.

Claim 38 (and the other independent claims) includes subject matter like that of claim 14, and it is therefore allowable for essentially the same reasons as claim 14, as is its dependent claim 39.

Claims 21, 29, 32, 33, 35, and 36 are rejected under 35 U.S.C. § 103(a) as assertedly unpatentable over the combination of Andreas in view of Odinak, in further view of Rajkotia, in further view of Kalavade, and in further view of U.S. Patent No. 6,714,860 ("Wawra").

Claims 21, 29, 32, 33, 35, and 36 depend from claim 14, and they are therefore allowable for at least the same reasons as claim 14, since Wawra does not cure -- and is not asserted to cure -- the deficiencies of the combination of Andreas, Odinak, Rajkotia, and Kalavade, as explained above as to claim 14.

Withdrawal of the obviousness rejections of claims 21, 29, 32, 33, 35, and 36 is therefore respectfully requested.

Claim 23 is rejected under 35 U.S.C. § 103(a) as assertedly unpatentable over the combination of Andreas in view of Odinak, in further view of Rajkotia, in further view of Kalavade, and in further view of Toshio.

Claim 23 depends from claim 14, and it is therefore allowable for at least the same reasons as claim 14.

Withdrawal of the obviousness rejection of claim 23 is therefore respectfully requested.

Claim 25 is rejected under 35 U.S.C. § 103(a) as assertedly unpatentable over the combination of Andreas in view of Odinak, in further view of Rajkotia, in further view of Kalavade, and in further view of U.S. Patent No. 6,667,726 ("Daminani").

Claim 25 includes subject matter like that of claim 14, and it is therefore allowable for essentially the same reasons as claim 14, since Damiani does not cure -- and is not asserted to cure -- the deficiencies of Andreas in view of Odinak, in further view of Rajkotia, in further view of Kalavade, as explained above as to claim 14.

Withdrawal of the obviousness rejection of claim 25 is therefore respectfully requested.

Claim 26 is rejected under 35 U.S.C. § 103(a) as assertedly unpatentable over the combination of Andreas in view of Odinak, and in further view of Rajkotia.

Claim 26 includes subject matter like that of claim 14, and it is therefore allowable for essentially the same reasons as claim 14, as explained above.

Withdrawal of the obviousness rejection of claim 26 is therefore respectfully requested.

Claims 34 and 37 are rejected under 35 U.S.C. § 103(a) as assertedly unpatentable over the combination of Andreas in view of Odinak, in further view of Rajkotia, in further view of Kalavade, in further view of Wawra, and in further view of Toshio.

Claims 34 and 37 depend from claim 14, and they are therefore allowable for at least the same reasons as claim 14, since Wawra and Toshio do not cure -- and are not asserted to cure -- the deficiencies of Andreas in view of Odinak, in further view of Rajkotia, in further view of Kalavade, as explained above as to claim 14.

Withdrawal of the obviousness rejections of claims 34 and 37 is therefore respectfully requested.

Accordingly, claims 14, 16 to 18, and 20 to 39 are allowable.

CONCLUSION

It is therefore respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

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